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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/481,577	01/12/00	TOOTHMAN, LLL	G

EXAMINER	
LEE, D	
ART UNIT	**PAPER NUMBER**
2876	

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DATE MAILED: 04/20/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/481,577	Applicant(s) TOOTHMAN, et al
	Examiner Diane Lee	Group Art Unit 2876

☒ Responsive to communication(s) filed on *Apr 25, 2000*.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-54* is/are pending in the application.

Of the above, claim(s) *41-54* is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-40* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☒ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

1. Claims 1-54 are presented for examination.

2. Receipt is acknowledged of the Preliminary Amendment filed 25 April 2000.

Election/Restriction

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-40, drawn to a system and method for providing specific memorial information (i.e., deceased party, historically information, geographical information, and etc.) having a memory device storing memorial information and affixed to an object at a specific location and a portable reading device retrieving the stored information from the memory device, classified in class 235, subclass 385.

II. Claims 41-54, drawn to a system and method for providing information using GPS receiver communicably connected to the database, classified in class 235, subclass 384.

4. The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and Group II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a system having a reading device retrieving specific information from stored in a memory device, and invention II has separate utility such as a system for retrieving information from GPS such as geographical information related travel. See MPEP § 806.05(d). Because these inventions are distinct for the reasons given above and have required a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Mr. McWilliams on 10 April 2001, a provisional election was made without traverse to prosecute the invention of Group I, claims 1-40. Affirmation of this election must be made by

applicant in replying to this Office action. Claims 41-54 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Specification

7. The disclosure is objected to because of the following informalities:

(a) Page 5, lines 14-17: "the mechanical and technical standards for which are available at http://www.ibuttom.com/ibuttoms/standard.pdf, are incorporated herein by reference" should be deleted because the embedded hyperlinks and/or other forms of browser-executable code in the specification are (see MPEP 608.01 (p), paragraph I regarding incorporation by reference). Appropriate correction is required.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 3-6, 17-18, and 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Assisi [US 5,696,488].

Re claims 1, 4-6 : Assis discloses a system having a device for storing retrieval information relating a deceased person, the system comprising:

a computer 5 having a memory device 6, 2 permanently affixed to a stationary physical object/location 1 positioned at the cemetery location, the memorial information residing on the memory device that is a weather resistant memory device (see col. 1, lines 4+; col. 2, lines 7+; and the figure);

a portable memory reading device 3, separate from the memory device, that retrieves the memorial information from the memory device when positioned at the cemetery location (i.e., wireless communication carried out when the portable memory reading device is brought into the vicinity of the memory device 2). The memorial information is in form of text, image or audio data of the deceased person in the cemetery (see col. 1, lines 35+ and col. 2, lines 23+);

Re claim 3: wherein the memory device contains personal information on the deceased person the device is connected to the transmitter/receiver device 2 so that the portable memory device can retrieve the information via wireless communication. Since the contents of the information stored in the memory device is determined by a person during his or her lifetime and that information is accessible via the reading device which clearly teaches that the memory device is a programmable read only memory device;

Re claim 17-18, 21-23: a central storage chamber 7 having a computer 5'as a communication controlling means and a storage device 6' as a database includes the memorial information residing on the memory device is replicated (see col. 2, lines 17+ and the figure). The computer 5 of the memory device having a restriction program to control the communication access to the memory device which inherently teaches that the memory device is uniquely associated with some sort of an identifying code (see col. 1, lines 36+).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 2, 7-16, 19-20, and 24-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Assis. The teachings of Assis have been discussed above.

Re claims 9, 11-14, 24-28, 30-31, 34-35, 38-40: Assis does not teaches the information in the memory device is a historically notable location or geographically remote location.

Due to the fact that Assis discloses a system having an electronic storage in communication with a reading device (i.e., the reading device retrieving data in the storage) and Assis further states that utilizing such system would provide unobtrusive communication between the visitor(s) and the site having a memory device, and the dignity of the location is not disturbed (see col. 2, lines 23+), it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to apply the Assis's teaching in museum or historical site in order to further extend the utilization of the electronic storage in communication with a reading device (i.e., museum or historical site having an electronic storage storing historical/geographical information in communication with a reading device and the reading device retrieving the stored historical data in the storage). Furthermore, it would have been an obvious intended use of the system since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham,* 2USPQ2d 1647 (1978).

Re claims 2, 10, and 29: Assis is silent with respect the memory device comprising a contact memory device.

Assis teaches a system utilizing a wireless communication, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to substitute the contactless memory device to a contact memory due to the fact that contact reading device would not requires a transceiver thereby it is cost effective and more reliable. Accordingly, it would have been an obvious substitution of equivalent therefore, it would have been an obvious expedient.

Re claims 7-8, 15-16, and 32-33: Assis is silent with respect to the specific language format of the information resides on the memory device such as extensible markup language or hypertext markup language formats.

Assis teaches that the information resides on the memory device may be in the form of text, image or audio data in any combination (see col. 1, lines 45-46).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to utilize any suitable language format appropriate to the system. Furthermore, since applicant has not discloses that utilizing extensible markup language or hypertext markup language formats in the memory device would solve any stated problems or is for any particular purpose and it appears that the invention would perform equally well with any other applicable language/text format that is available. Therefore, it would have been an obvious design variation to a person skilled in the art. One might choose the specific text format in order to meet specific communication standards/requirements. Accordingly, it would have been an obvious expedient.

Re claims 19-20 and 36-37: with respect to accessing the information through an Internet or telephone network, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the Internet-based communication process in the system Assis (i.e., storing the information in a database over the Internet server and retrieving the information over the Internet). Doing so would provide a convenience of retrieving the information at user's home. Official Notice is taken that retrieving data through the networks (i.e., includes telepone network and Internet) assocated with unique identification code is old and well known in the art. See In Re Malcolm 1942 C.D.589:543 O.G. 440. Thus, it would have been obvious to an artisan of ordinary skill in the art incorporate well-known network-accessible database and unique identification code to be associated with the gathered data in the

system of Assis. Accordingly, it would have been an obvious extension taught by Assis therefore, it would have been an obvious expedient.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Schnase et al. [US 6,078,928] discloses a system for retrieving information related to various site, exhibits to the user reading device;

Machiraju et al. [US 6,028,601] discloses system that user retrieving information from network accessible database; and

Obara [JP 09-062651 A] and Ahnert [DE 35 33 705 A1] discloses a system retrieving the information about a historical information.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane Lee whose telephone number is (703) 306-3427. The examiner can normally be reached on Monday to Thursday and every other Friday (second Friday of the bi-week) from 6:30 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Lee, can be reached on (703) 305-3503. The fax phone number for this Group is (703) 308-7722.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to **[michael.lee@uspto.gov]**.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Diane Lee
Art Unit 2876
April 18, 2001

MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
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